AUG 7 1953
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1953

No. 240

SEARS, ROEBUCK AND CO.,
Petitioner,

vs.

JOHN A. MARZALL
(ROBERT C. WATSON, substituted),
COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

To the Honorable, The Chief Justice and the Associate Justices of the Supreme Court of the United States:

Sears, Roebuck and Co. respectfully petitions for a writ of certiorari to review a final judgment of the United States Court of Appeals for the District of Columbia Circuit which affirmed a judgment of the United States District Court for the District of Columbia dismissing Petitioner's complaint in the above entitled suit.

The District Court issued no opinion other than Findings of Fact and Conclusions of Law submitted by Respondent-Defendant. (R.* 75, 76; District Court Judgment, R. 77.)

The opinion of the Court of Appeals is at R. 79.

* Transcript of Record.

STATEMENT OF THE MATTER INVOLVED.

Petitioner filed its complaint in the District Court under R. S. Sec. 4915, Feb. 9, 1893, C. 74, Sec. 9, 27 Stat. 436, 35 U.S.C. Sec. 63, and Sec. 21 of Trade-Mark Act of 1946, C. 540, Title 1, Sec. 21, 60 Stat. 435, 15 U.S.C. Sec. 1071, asking for a judgment that Petitioner is entitled to registration of its trade-mark J C HIGGINS under Sec. 2(e) of the Trade-Mark Act of 1946, P.L. 489, 79th Cong. Ch. 540, 60 Stat. 427, 15 U.S.C. Ch. 22, which registration had been refused by the Commissioner.

The refusal to register was based on Sec. 2 of the 1946 Trade-Mark Act (15 U.S.C. 1052), R. 71, reading:

> "Sec. 2. No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it * * * (e) consists of a mark which * * * (3) is primarily merely a surname."

The Commissioner took the position that the surname Higgins is "the only significant part of the mark" J. C. HIGGINS (R. 54) and "that the addition of the initials does not change the surname to a mark which is not primarily merely a surname" (R. 58).

Petitioner is in the retail general merchandise business. In 1906 it adopted as a trade-mark for sporting goods the notation J C HIGGINS. The company executives, wanting a name type of trade-mark, chose that of one John Higgins, then an official of the company, with his consent. Finding that Higgins lacked a middle initial, they gave him one (Stip. of Testimony, Pltf's. Ex 2—Designation Contents of Rec. on App. Item 5). Higgins, alive when the application for registration was filed, says in a sworn statement (R. 8), "My name was adopted, with my per-

mission * * the name applied to the merchandise is 'J. C. HIGGINS' ".

The mark has been used in the form J C HIGGINS ever since and extended to include a huge list of sporting goods (see matchbook, Pltf's. Ex. 4). As shown by the collection of labels (Designation of Contents of Rec. on App., Item 18), the mark as used on the goods is written in letters of equal size and prominence in script form like a signature, though not actually a signature; likewise, in Petitioner's advertising (Designation, Items 15, 16, 17), the mark, either in script or block letters, emphasizes *no* part of the name.

The Patent Office admits that J C HIGGINS qualifies as a trade-mark and may be registered under Section 2(f) of the 1946 Trade-mark Act (R. 55, 16). This Section provides for registration of marks which have acquired distinctiveness (secondary meaning) by reason of five years' user or otherwise, where not otherwise registrable. Applicant, thus far, has declined such registration for the reason that it believes it is entitled to registration without recourse to Section 2(f); if Petitioner is correct, it feels it should not be required to accept a protection which may be of second grade.

Copending in the Patent Office with the application here involved and presently awaiting a final determination in the instant litigation are 16 additional applications for registration of J C HIGGINS, filed by Petitioner to cover numerous additional items of sporting goods in various Patent Office trade-mark classifications. All ask for registration on the Principal Register without recourse to Sec. 2(f).

At the "trial" in the District Court Petitioner was prepared to offer in evidence certain documentary material and oral evidence through a responsible official of Petitioner's brought to Washington especially for the trial, which would have refuted the Patent Office view that the surname Higgins is "the only significant part of the mark", consisting of Petitioner's labels and advertising, communications of customers, and trade publications, all showing general use by Petitioner *and the public* as the *complete unit,* J C HIGGINS. The Trial Judge, on the ground that the suit involves merely a question of law (R. 27), refused to permit the witness to be sworn and refused to accept any of the material offered by Petitioner except a certified copy of the application (Pltf's. Ex. 1), a stipulation explaining the circumstances of adopting the mark (Pltf's. Ex. 2) and a matchbook advertising J C HIGGINS goods. Thus, the "trial" was limited essentially to colloquy between counsel and the Court.

Thus, Petitioner was barred by the Trial Court from presenting its evidence which would have completely refuted the point that the Patent Office had made the very crux of the case.

The Court of Appeals lightly dismissed this action of the Trial Court in denying Petitioner the right to present its evidence with a brief footnote in its opinion, though presented as a point of appeal.

BASIS OF JURISDICTION TO REVIEW THE JUDGMENT.

This petition is filed under 28 U.S.C. 1254 (1) and Supreme Court Rule 38, and particularly Sections 5(b) and 5(c) thereof.

The judgment here sought to be reviewed was rendered March 12, 1953; extension of time to file this petition was granted June 9, 1953, by this Court.

The question of trade-mark law here involved, which is one of interpretation of a Federal statute, is of major importance to the nation's business community in general, and in the administration of that statute in the Patent Office.

The statutory provision here involved, namely, Sec. 2 (e)(3) of the 1946 Trade-Mark Act, has not heretofore come before this Court for interpretation. That this Honorable Court's guidance is required is indicated by a recent expression of the Court of Customs and Patent Appeals in *In re I. Lewis Cigar Mfg. Co.*, 98 USPQ No. 6, Aug. 10, 1953, involving the question of registration under the same section of a mark which that Court considered specifically different from J C HIGGINS. The Court stated not only that it considered Sec. 2(e)(3) ambiguous but that even a reading of the Congressional committee hearing reports bearing thereon failed to clarify the section. (Opinion attached as appendix hereto, p. 4a)

There is an apparent conflict in the views of the Court of Appeals in the instant case and those of the Court of Customs and Patent Appeals in I. Lewis Cigar Mfg. Co., Inc., ibid. (Appendix hereto, pp. 3a-4a) regarding registrability of J C HIGGINS. (See quotation from opinion, infra, pp. 7-8.)

It is believed that the Court of Appeals in the instant case has improperly construed this section as identical in meaning with corresponding Section 5 of the superseded 1905 Trade-Mark Act (U.S.C. Title 15, Sec. 85), even though the two sections are couched in radically different language.

The matter of statutory interpretation should, therefore, be settled by this Court. *Pecheur Lozenge Co.* v. *National Candy Co.*, 315 U.S. 666, 86 L. ed. 1103; *Steele* v. *Bulova Watch Co.*, 344 U.S. 280.

THE QUESTIONS PRESENTED.

1. In enacting Sec. 2(e)(3) of the 1946 Act, barring registration of a mark which is "primarily merely a surname," did the Congress intend to re-enact Sec. 5 of the 1905 Act which barred registration of a mark "which consists merely in the name of an individual"? The Patent Office and its appellate tribunals seem to think so; Petitioner believes not.

2. In the trade-mark J C HIGGINS, is the surname Higgins the "only significant part of the mark", as held below, and, as a consequence, is J C HIGGINS barred from registration by the Statute as "primarily merely a surname"? Petitioner believes not.

REASONS RELIED ON FOR ALLOWANCE OF THE WRIT.

1.

The statutory provision which this Court is requested to interpret is "ambiguous" and Congressional intent is "not clearly established" even by the hearing reports, according to the Court of Customs and Patent Appeals in *In re I. Lewis Cigar Mfg. Co.*, 98 USPQ No. 6, Aug. 10, 1953 (Appendix hereto, p. 4a).

2.

The Patent Office has taken a confused and "inconsistent standard" in the interpretation of Sec. 2(e)(3). *In re I. Lewis, Ibid.*, Appendix, p. 3a. In the first case considered by it on appeal to the Commissioner, *Ex parte Dallioux*, 83 USPQ 262, the Patent Office permitted registration on the Principal Register, without recourse to Sec. 2(f), of the mark ANDRE DALLIOUX on the mistaken theory that it was a "full name", although the applicant's name was actually Andre *Julien* Dallioux.

The Committee Reports show that the term "full name" was considered at one time as a prerequisite for registration but "full" was later dropped in favor of the language, "primarily merely a surname".

After the *Dallioux* decision, the Patent Office refused registration of J C HIGGINS in the instant case. As stated by the Court of Customs and Patent Appeals in *In re I. Lewis Cigar Mfg. Co.*, 98 USPQ No. 6, Aug. 10, 1953 (Appendix hereto, pp. 3a-4a):

> "• • • It seems to us that the initials in the Higgins mark should have received equal consideration to that

given "Andre" in the Dallioux mark. We strongly doubt that Congress intended such a decisive distinction to be made between initials and given names in determining whether a mark is primarily merely a surname."

3.

The position taken by the Patent Office on registrability of name marks and adopted by the Court of Appeals in this case, indicates that the Patent Office has persistently construed Sec. 2(e)(3) of the 1946 Act as substantially a rewrite of Sec. 5 of the 1905 Act, although the two laws (R. 71) employ radically different language, the 1905 Act prohibiting registration of a mark which "consists merely in the *name of an individual*" while the 1946 Act specifies "primarily merely a *surname*". (Emphasis added.)

In reversing the Examiner's refusal to register ANDRE DALLIOUX, the Commissioner said:

> "To refuse registration of the mark as shown in the drawing would be in effect to continue the rule of the Act of 1905, even though the prohibition against registration of a mark consisting of the name of an individual (which included surnames but was not limited thereto), no longer remains in the law." *Ex parte Dallioux,* 83 USPQ 262.

Following the *Dallioux* decision, the Patent Office has accepted it as a mandate to register *only* marks of the "John Smith" pattern, but nothing else, excluding J. C. SMITH and the like, apparently adopting the Commissioner's false impression that ANDRE DALLIOUX was a "*full* name"—a restriction deliberately *omitted* from the Act.

4.

The Court of Appeals in the instant case has fallen into the same error, stating:

> " • • • under the 1905 Act 'J C HIGGINS' alone, being 'merely the name of an individual', also would have been unregistrable. Section 5, 33 Stat. 726. Should a different result now follow on the theory that the two initials prevent 'J C HIGGINS' from being merely, or primarily merely, a surname and *make it an entire name?*" (Emphasis added)

The Court of Appeals then refers to *Ex Parte Dallioux,* 83 USPQ, as having "ruled that 'Andre Dallioux' was neither merely, nor primarily merely, a surname but was the *entire name* of an individual" (emphasis added)—an *erroneous* assumption, for DALLIOUX had *two* given names, not merely ANDRE.

Thus, the Court of Appeals in the instant case based its conclusion on a faulty conception of the Statute regarding "full name," which conception was suggested by the prior error of the Commissioner in the *Dallioux* case, and we find a *chain of errors.*

5.

The only authority relied on by the Court of Appeals was the Supreme Court's decision in *Thaddeus Davids Co.* v. *Davids,* 233 U.S. 461 (1914), a trade-mark *infringement* suit. Being basically an equity suit for unfair competition, this Court properly compared the labels of the competing products and found from such comparison a wilful attempt to prey on the plaintiff's good will and to create confusion, holding that "the use of the name *in this manner* • • • constituted a colorable imitation within the meaning of the Act." (Emphasis added.) The case, therefore, has no bearing on the question herein, which is strictly one of *registrability* under a specific statutory provision.

The only other cases referred to by the Court of Appeals dealt with registration under the now obsolete 1905 Act,

namely, *Howard Co.* v. *Baldwin Co.*, 48 App. D.C. 437 (1919) and *In re Sears, Roebuck & Co.*, 132 F. 2d 341 (1942). These cases, likewise, are irrelevant for, as noted above, the 1946 Act is radically different in verbiage and, we maintain, also in meaning.

6.

The Court of Appeals, in holding J C HIGGINS unregistrable because "primarily merely a surname", has disregarded and gone contrary to the expressed objectives of the 1946 Act, and more particularly the following (H.R. Rept. No. 603 to accompany H.R. 82, 78th Cong., 1st Session; Senate Rept. No. 1303, Calendar No. 1302, to accompany H.R. 82, 78th Cong., 2d Session):

> "The purpose of this bill is to place all matters pertaining to trade-marks in one statute and to eliminate judicial obscurity, to simplify registration and to make it *stronger and more liberal, to dispense with mere technical prohibitions and arbitrary provisions.*" (Emphasis added.)
>
> • • •
>
> "3. To modernize the trade-mark statutes so that they will conform to legitimate present-day business practice.
>
> "4. To remedy constructions of the present acts which have in several instances obscured and perverted their original purpose. These constructions have become so ingrained that the only way to change them is by legislation."
>
> "• • • a sound public policy requires that trade-marks should receive nationally the greatest protection that can be given them."

7.

The Court of Appeals has disregarded the mandate of this Honorable Court in *Beckwith* v. *Commissioner of Patents,* 252 U.S. 538, 64 L. ed. 705, 707, where, in construing the 1905 Trade-Mark Act, this Court, speaking through Mr. Justice Clark, said:

> "* * * the requirement of the statute that *no trade-mark shall be refused registration* except in designated cases is *just as imperative as the prohibition* of the proviso against registration in cases specified." (Emphasis added.)

Substantially the same statutory language, "No trade-mark * * * shall be refused registration * * * unless," etc., *is repeated* in Sec. 2 of the 1946 Act.

The above quoted rule was considered of such importance by this Court that it was repeated on page 708, 64 L. ed., after which the Court continued:

> "Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, and *this should not be done if it can be avoided by fair, even liberal, construction of the Act,* designed, as it is, to promote the domestic and foreign trade of our country." (Emphasis added.)

8.

The Court of Appeals has disregarded a basic rule of trade-mark law, as laid down by this Honorable Court in *Beckwith* v. *Commissioner of Patents,* 252 U.S. 538, 546, 64 L. ed. 705, 708, *viz.*:

> "The commercial impression of a trade-mark is derived from it *as a whole,* not from its elements separated and considered in detail. For this reason it should be considered in its entirety (*Johnson* v.

Brandau, 32 App. D.C. 348), and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value."

The Court of Appeals improperly dissected the mark J C HIGGINS in holding that it is "primarily merely a surname," despite the fact that the entire mark is written in letters of equal prominence and the surname is not emphasized in any way.

The Court of Customs and Patent Appeals recently had the following to say about disregarding *one letter* in a trade-mark:

> "Certainly, in considering confusion, one is not at liberty to treat as elided a letter which gives distinctiveness to a mark." *Cont. Coffee Co.* v. *Cont. Foods,* 202 F. 2d 759, 761 (CCPA, 1953).

Yet in the instant case *two* letters are, in effect, elided.

9.

The Court of Appeals has disregarded the basic principle laid down by this Honorable Court in *Howe Scale Co.* v. *Wyckoff,* 198 U.S. 118, 140, 25 S.Ct. 609, 49 L. ed. 972, that:

> "in the absence of contract, fraud or estoppel, any one may use his own name in all legitimate ways * * *"

It has been recognized that initials alone may distinguish one trader from another. *Henry Perkins* v. *Perkins,* 246 Mass. 96, 140 N.E. 461, 13 T.M. Rep. 370.

In the instant case, the only registration cited by the Patent Office, covering the trade-mark "Higgins" (R. 60), was withdrawn (R. 40) after the proprietor, Higgins Industries, Inc., wrote "* * * we can foresee no conflict between your trade-mark and that of our 'Higgins'

• • •" (R. 39). The duty of the Patent Office to protect the public was thus discharged.

10.

The Court of Appeals has applied a meaning to the statute which is believed to be unwarranted by the language thereof.

In the expression, "primarily merely a surname", the word *primarily* is explained by the drafters of the law (see comments of Mr. Edward S. Rogers in Committee Reports, R. 61-66), as designating a name such as Johnson, as distinguished from Cotton, King, etc., which have dictionary meanings. Unquestionably, Higgins is primarily a surname, like Johnson.

But the word *merely* is defined as "not otherwise than; simply; barely; only, as, he came *merely* to see and talk with his friends." Webster's New International Dictionary, 2d ed., unab., G. & C. Merriam Co. By this definition, J C HIGGINS is not "primarily *merely* a surname".

11.

The documentary proofs offered by Petitioner and excluded by the Trial Court disprove the contention that Higgins is "the only significant part of the mark".

Thus, Petitioner's labels and advertising show that no emphasis has ever been placed by Petitioner on any *part* of the mark, J C HIGGINS.

Correspondence from customers and trade literature show that the public knows the mark only as J C HIGGINS, not as Higgins.

The page from the Washington telephone directory shows it to be commonplace for persons having the same

surname to identify themselves by initials, without spelling out the given name. Thus, initials alone *do identify*, they *do serve to distinguish*, contrary to the position taken by the Court of Appeals. No one would question the identity of TR or of FDR.

CONCLUSION.

The Patent Office has been confused in interpreting Sec. 2(e)(3) of the 1946 Trade-Mark Law as substantially a repetition of Sec. 5 of the former 1905 Act, besides erroneously reading into the statute a requirement that a name has to be a "full" name in order to be registrable. These errors have been inadvertently adopted by the Court of Appeals, as clearly shown in its opinion herein.

A perpetuation of such error will greatly prejudice the interests of the business community in general in the protection of trade-marks.

Therefore, your petitioner respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia Circuit to review and correct the errors above referred to.

Respectfully submitted,

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Aug. 8, 1953.

APPENDIX.

Date of Decision—June 24, 1953

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

In the Matter of the Application of I. Lewis Cigar Manufacturing Co.	October Term 1952 Patent Appeal No. 5943 Patent Calendar No. 44 Serial No. 543,497.

Worley, *Judge.*

This is an appeal from the decision of the Commissioner of Patents affirming the rejection by the examiner of the application for registration filed December 5, 1947, under the provisions of Section 2(e) of the Lanham Act (Trade-Mark Act of 1946), of the notation "S. Seidenberg & Co's." Registration was denied on the ground that the mark sought to be registered was primarily merely a surname within the meaning of the involved section.

The pertinent portions of that section read as follows:

Sec. 2. Trade-marks registrable on the Principal Register

> No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it— * * * (e) Consists of a mark which, * * * (3) is primarily merely a surname. (60 Stat. -28, 15 U.S.C., sec. 1052.)

The record reflects that the mark has been used continuously by the applicant and its predecessors since prior to 1899; that it was originally registered under the Trade-

Mark Act of 1905, as amended, on June 12, 1934 (T.M. 313, 810); and that it was republished under the provisions of the Lanham Act, *supra,* January 18, 1949. The mark, which appears to be printed in Old English or a modified Black Letter type, is applied to applicant's cigars by being printed on wrappers enclosing the cigars and also on labels pasted on the cigar boxes.

The examiner refused registration on the ground that the word "Seidenberg" constituted the dominant and significant feature of the mark and relied on the decision in the case of *Ex parte Sears, Roebuck & Co.*, 87 USPQ 400 (affirmed March 12, 1953, ... U. S. App. D. C. ....., 96 USPQ 360).

Upon appeal to the commissioner, the appellant renewed its contention that the involved mark could not be classified as being primarily merely a surname because the additions of the single initial and the terminal portion "& Co's." together with the distinctive fashion in which they are printed, were sufficient to remove the mark from that category.

The commissioner, in rejecting those contentions, stated

> In the *Sears, Roebuck and Co.* case relied upon by the examiner, it was held that the term "J. C. Higgins" was unregistrable because the addition of initials to the surname does not change the mark as a whole from being primarily merely a surname. It is my view that in the present case "S. Seidenberg" without the terminal portion "& Co's." would be clearly unregistrable as a trade-mark because it is *primarily* merely a surname for the same reasons stated in the *Sears, Roebuck & Co.* decision, and I am further of the opinion that the addition of the expression "& Co's." adds nothing distinctive in the applicant's mark since it has been the uniform practice

> to ignore such expressions on the theory that they do not serve to identify any particular company. The possessive form in which the expression "& Co's." appears is considered of no significance in this regard any more than if the "S" had been appended to the surname "Seidenberg." (Italics quoted.)

It appears that the two leading cases which have emerged as a result of the interpretations of the instant paragraph by the Patent Office are *Ex parte Dallioux*, 83 USPQ 262, and *Ex Parte Sears, Roebuck & Co., supra.* In the former, the mark "Andre Dallioux" was allowed on the theory that it was the full name[1] of the applicant and, therefore, consisted of something more than primarily merely a surname.

In the *Sears, Roebuck & Co.* case, *supra,* the notation "J C Higgins" was denied registration on the theory that the word "Higgins" was the dominant part of the mark and that the addition of the initials did not prevent that mark from being considered to be primarily merely a surname.

It seems to us that the Patent Office, in the difficult task of fairly interpreting the involved section, has adopted an inconsistent standard in its consideration of the two marks cited above. It would appear that had the reasoning employed in the *Higgins* case; namely, that "Higgins" constituted the dominant part of that mark, been consistently employed, then that reasoning, when applied to "Andre Dallioux," would necessarily have resulted in its rejection because "Dallioux" is, in our opinion, the dominant part of that mark.

Conversely, it seems to us that the initials in the Higgins mark should have received equal consideration to

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[1] Not literally correct since the full name was Andre Julien Dallioux.

that given "Andre" in the *Dallioux* mark. We strongly doubt that Congress intended such a decisive distinction to be made between initials and given names in determining whether a mark is primarily merely a surname.

Here, however, the mark before us is different from both of the above marks.

This case was first argued January 16, 1953. At the conclusion thereof there was a substantial doubt in our minds as to exactly what Congress intended by the language employed in Section 2(e). Since, in our opinion, there was some degree of ambiguity in that language, and since the instant case is one of first impression in this court, reargument, with particular reference to Congressional intent, was requested. Reargument was had on May 15, 1953. Despite able presentation by counsel, however, Congressional intent was not clearly established. Even if we would be justified in accepting the testimony of interested witnesses before the committee having charge of the involved legislation, here that testimony is inadequate.

Turning then to what we consider to be the ordinary meaning of the words used in Section 2(e), we refer to the case of *Beckwith* v. *Commissioner of Patents,* 252 U.S. 538, 1920 C. D. 471. In that case the word "merely" was held to be synonymous with "only." Applying that definition here, as the notation "S. Seidenberg & Co's." merely or only a surname? Literally it is something more than that. However, is it primarily[2] only a surname?

---

[2] Webster's New International Dictionary, Second Edition, Unabridged, 1949:

primarily, adv. In the first place; originally, preeminently; fundamentally; as, an action primarily based on policy.

primary, adj. * * * 1. First in order of time or development or in intention; primative; fundamental; original; initial. * * *

It seems to us that "Seidenberg" is clearly a surname which can have no other meaning or significance than that of a surname. Nor do we believe that the addition of the single initial is sufficient to remove it from that category. Further, the addition of the expression "& Co's.," whether it be in the abbreviated and possessive form present here, or in the usual form, cannot be held to distinguish or relate to anything except the surname "Seidenberg."

It is our conclusion, therefore, that the action of the Patent Office in holding that the involved mark was not more than primarily merely a surname, within the meaning of Section 2(e), was correct.

We note the statement of the commissioner that the mark of the applicant might well qualify for registration under the provisions of Section 2(f) of the Lanham Act.[3] We see nothing in the record before us which might cause us to have any different view from that expressed by the commissioner.

The decision of the Commissioner is affirmed.

Affirmed.

[3] Sec. 2(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration. (15 U.S.C. 1052).

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In the Supreme Court of the United States

OCTOBER TERM, 1953

No. 240

SEARS, ROEBUCK AND COMPANY, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The Findings of Fact and Conclusions of Law of the United States District Court for the District of Columbia (R. 75-77) are not reported. The opinion of the United States Court of Appeals for the District of Columbia Circuit (R. 79-84) is reported at 204 F. 2d 32.

JURISDICTION

The judgment of the Court of Appeals was entered on March 12, 1953 (R. 85). By order of Mr.

Chief Justice Vinson, dated June 9, 1953, the time for filing a petition for a writ of certiorari was extended to and including August 8, 1953 (R. 86). The petition for a writ of certiorari was filed on August 7, 1953. The jurisdiction of this court is invoked under 28 U.S.C. 1254.

QUESTION PRESENTED

Whether the trade-mark "J C Higgins" is "primarily merely a surname" within the meaning of Section 2(e) of the Lanham Act of 1946, which prohibits the registration of a mark which is "primarily merely a surname."

STATUTE INVOLVED

The Lanham Act of July 5, 1946 (60 Stat. 427, 15 U.S.C. 1051-1127) provides, in pertinent part, as follows:

> SEC. 2. No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
>
> * * * * *
>
> (e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registra-

ble under section 4 hereof, or (3) is primarily merely a surname.

(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.

STATEMENT

This is an equitable proceeding brought pursuant to R. S. 4915 to compel the registration of a trade-mark (R. 2-8).[1] The material facts, which are not disputed, are as follows:

In 1908, petitioner adopted "J C Higgins" as a trade-mark for sporting goods (R. 75). The mark, which is not written, printed, impressed or woven in any particular or distinctive manner, has been used extensively by petitioner since its adoption (R. 76, 79).

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[1] R. S. 4915 (35 U.S.C. (1946 ed.) 63) was made applicable to trade-mark proceedings by Section 21 of the Lanham Act (15 U.S.C. 1071). R. S. 4915 was repealed effective January 1, 1953, by Section 5 of the Act of July 19, 1952, 66 Stat. 792, 815-816, which revised and reenacted into positive law Title 35 of the United States Code. Existing rights and liabilities were not affected by the repeal. Its provisions were reenacted into law, with changes not material here, as Sections 145 and 146 of Title 35. 66 Stat. 803.

In 1948, petitioner applied to the Patent Office for registration of the mark, expressly negating that the application was under Section 2(f) of the Lanham Act (15 U.S.C. 1052(f)) (*supra* p. 3), which authorizes registration of a mark which "has become distinctive, as applied to the applicant's goods in commerce." (R. 7, 55, 79). The Patent Office refused registration on the ground that registration of a mark which is "primarily merely a surname" is prohibited by Section 2(e) of the Lanham Act (15 U.S.C. 1052(e)) (*supra*, pp. 2-3) (R. 54-58). The Patent Office acknowledged, however, that the mark was eligible for registration under Section 2(f) (R. 45, 55).

After registration was denied by the Patent Office, petitioner filed the instant equitable proceeding under R. S. 4915 praying for a declaration that petitioner is entitled to registration of "J C Higgins" under Section 2(e), apart from the provisions of Section 2(f) (R. 7). The District Court dismissed the complaint, holding, as a matter of law, that the surname "Higgins" is "the salient, dominant, preeminent and clearly noticeable part" of the mark "J C Higgins," and, accordingly, that "J C Higgins" is "primarily merely a surname" (R. 76). The Court of Appeals affirmed, "without prejudice to any application which might be filed for registration under Section 2 (f)." (R. 84).

ARGUMENT

1. Petitioner's basic contention here is that the Patent Office and both courts below have defeated

the intention of Congress to liberalize the trademark law by erroneously construing Section 2(e) of the Lanham Act of 1946 (15 U.S.C. 1052(e)) as "identical in meaning with" and as "substantially a repetition of" Section 5(b) of the Trade-Mark Act of 1905 (15 U.S.C. (1946 ed.) 85(b)) (Pet. 5, 6, 8, 10, 14). This contention is directly refuted by the text of the opinion below and by the pertinent decisions of the Patent Office.

Section 5(b) of the Act of 1905 prohibited registration of a mark "which consists *merely in the name of an individual,* firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner * * *" (emphasis added) (15 U.S.C. (1946 ed.) 85 (b)). In applying Section 5(b), the phrase "name of an individual" was construed as including, but not restricted to, surnames. *American Tobacco Co.* v. *Wix,* 62 F. 2d 835 (C.C.P.A.); *Wm. A. Rogers, Ltd.* v. *International Silver Co.,* 34 App. D. C. 410; *In re A. G. Spalding & Bros.,* 27 App. D. C. 314; *Tinker* v. *M. F. Patterson Dental Supply Co.,* 287 Fed. 1014 (C.A.D.C.)[2] Further, registration was

[2] This interpretation was in accord with the well settled rule that a surname is not the subject of exclusive appropriation as a common law trademark. *Thaddeus Davids Company* v. *Davids,* 233 U.S. 461, 464; *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict,* 198 U.S. 118, 134. In this connection, it should be pointed out that petitioner's quotation from the *Howe Scale Company* case, *supra* at 140, that "in the absence of contract, fraud or estoppel, any man may use his own name, in all legitimate ways" (Pet. 12), is misleading. While this quotation is accurate, the Court also stated "that a personal name cannot be exclusively appropriated by any one as against others having a right to use it; and as the name 'Remington'

denied of a word which appears as a surname in a telephone book or city directory even though the word has significance other than as a surname, *e.g.*, "Cotton", "Wood", "Lamb". *In re Sawyer Electrical Mfg. Co.*, 144 F. 2d 893 (C.C.P.A.); *In re Nisley Shoe Co.*, 58 F. 2d 426 (C.C.P.A.). See also Ooms, *How The Lanham Act Affects Trade-Marks*, 37 T.M. Rep. 383, 384; Derenberg, *At the Threshold of The Lanham Trade-Mark Act*, 37 T. M. Rep. 297, 302. In addition, it was held that a mark was "*merely* in the name of an individual" if a surname or a full name was the dominant feature of the mark, *i.e.*, that the addition of initials, designs, pictures or other words does not make a mark registrable if it is dominated by a surname. *In re Sears, Roebuck & Co.*, 132 F. 2d 341 (C.C.P.A.); *In re C. W. Marks Shoe Co.*, 131 F. 2d 437 (C.C.P.A.); *Howard Co.* v. *Baldwin Co.* 48 App. D. C. 437, certiorari denied, 256 U.S. 35; *Oliver Chilled Plow Works* v. *The Wm. J. Oliver Mfg. Co.*, 40 App. D. C. 125; *In re Artesian Mfg. Co.*, 37 App. D. C. 113; cf. *J. B. Williams Co.* v. *Williams*, 48 F. 2d 398 (C.C.P.A.); *Thaddeus Davids Co.* v. *Davids*, 233 U.S. 461.

As revised by Section 2(e) of the Lanham Act (15 U.S.C. 1052(e)), registration is now prohibited of a mark which is "primarily merely a surname." Admittedly, the addition of the word "primarily"

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is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not in itself give it validity" (198 U.S. at 134-135).

as a modifier of "merely" and the substitution of "surname" for "name of an individual" was a liberalization of the prior law. Contrary to petitioner's assertion that the Patent Office regards Section 2(e) as a reenactment of the prior law, the pertinent decisions of the Patent Office reveal that full effect has been given to these changes.[3] Thus, since registration is now prohibited of a "surname" rather than of a "name of an individual," registration was granted for "Andre Dallioux"—the "name of an individual." *Ex parte Dallioux*, 83 USPQ 262.[4] Similarly, heedful of the word "pri-

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[3] Recognition by the court below of these specific changes and of the intention of Congress to liberalize the law is also clearly revealed in the instant opinion. Thus, in holding against petitioner, the court expressly stated as follows: "The intention of Congress to liberalize the law is not defeated. Such intention is carried out. For example, the old law was changed so as not *per se* to prohibit registration of 'individual, firm, corporation or association' names. The term 'surname' applies only to individuals and so the name of a corporation, firm or association is not now unregistrable merely because it is such a name. Furthermore, there was previously no property right in the name itself but only in the distinctive design in which it was embodied. This is not now the case. Compare 33 Stat. 726 (1905), *supra*, with Section 2(e)(3) of the 1946 Act, n. 1, *supra*. And, as we have seen, the telephone book or city directory test is eliminated" (R. 84).

[4] Petitioner states that this ruling of the Patent Office was made under the false impression that "Andre Dallioux" was the applicant's "full" name, and that the court below has fallen into the same error in the instant case (Pet. 8-9). This assertion is without merit. That Dallioux had two given names is apparent on the face of the decision of the Patent Office, which recites that it has reference to the "application for registration of trade mark of Andre Julien Dallioux, Serial No. 537,402, filed Oct. 10, 1947." 83 USPQ 262. The basis for the decision was not that Andre Dallioux was the applicant's "full" name but that Andre Dallioux was the "name of an individual" rather than a "surname." It should also be pointed out that the instant decision is in accord with the *Dallioux* decision.

marily," registration was granted for the word "Samson" on the ground that it is not "*primarily* merely a surname." *Ex parte Keuffel & Esser Co.*, 96 USPQ 216.

2. Accordingly, the question presented here is not the broad one whether the Patent Office and both courts below have erroneously construed Section 2(e) of the Lanham Act as "identical in meaning with" Section 5(b) of the Act of 1905, but the narrower issue whether the Patent Office and both courts below erred in holding that a particular collocation of words, *i.e.*, "J C Higgins", is "primarily merely a surname."

Concededly, "Higgins" is primarily a surname (Pet. 13). Petitioner contends, however, that "merely" means "only" and that, by this definition, "J C Higgins" is not "primarily *merely* a surname" (Pet. 13). Literally read, "J C Higgins" is something more than only a surname. However, petitioner points to nothing in the legislative history which suggests that "merely" is to be read that literally.[5] Since the 1905 Act similarly prohib-

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The opinion of the Commissioner of Patents in the *Dallioux* case expressly points out that the result reached there "would, of course, not apply in the event the surname was unduly emphasized or otherwise constituted the only significant part of the mark, thereby amounting to 'a mere device or contrivance to evade the law and secure the registration of nonregistrable words * * *,' (*Beckwith* v. *Commissioner of Patents*, 252 U.S. 538, 1920 C.D. 471)." 83 USPQ 263. The Patent Office, in the instant case, expressly followed this admonition (R. 54-58).

[5] Other than stating that Congressional intent is not clearly established by the legislative history (Pet. 7), petitioner's only reference to the legislative history is the assertion that "The

ited registration of a mark which was "*merely* in the name of an individual," and there is nothing which would indicate that Congress intended the word "merely" to be given a different meaning in the Lanham Act, Congress must be deemed to have adopted the definition given that word by the Patent Office and the courts under the 1905 Act.

As noted above, pp. 5-6, under the earlier Act, it was uniformly held that a mark was "merely" the name of an individual if a surname was the dominant feature of the mark. Applying this definition of "merely," it is clear, as the Patent Office and both courts below held, "that the initials ['J C'] are not sufficient to prevent the mark from consisting of 'primarily merely a surname.'" (R. 83). But even assuming, contrary to the reasoning of the earlier cases, that "J C Higgins" is not "merely" a surname, it is, as the court below pointed out, "principally merely a surname and, therefore, primarily merely so." (R. 84).

Committee Reports show that the term 'full name' was considered at one time as a prerequisite for registration but 'full' was later dropped in favor of the language, 'primarily merely a surname.'" (Pet. 7). Petitioner does not particularize the Committee Reports to which it refers in this connection, but presumably petitioner has reference to the extracts set forth in the Record, pp. 61-66, from the Hearings held by the Subcommittee on Trade-Marks of the House Committee on Patents in 1939 on a bill then under consideration. In our view, these hearings, some seven years prior to the enactment of the Lanham Act, are of slight relevance. (For a chronological listing of the legislative history of the Lanham Act, see Toulmin, *Trade-Mark Act of 1946*, pp. 154, *ff.*) In any event, these extracts shed little light on the meaning of the word "merely". Further, contrary to petitioner's assertion that the Committee was considering the use of the term "full name" as a prerequisite for registration, the statutory language then under consideration would have barred registration of a "full name."

3. This conclusion is fully in accord with the decision of the Court of Customs and Patent Appeals in *In re I. Lewis Cigar Mfg. Co.,* 98 USPQ No. 6, August 10, 1953 (Pet. App. 1a-5a). It is true, as petitioner points out (Pet. 7-8), that the Court of Customs and Patent Appeals said by way of dictum in the *Lewis Cigar* case that the Patent Office had adopted an inconsistent standard in its consideration of the instant case and the *Dallioux* case—observing that registration should have been denied in *Dallioux* on the reasoning of the present case, and, conversely, that registration should have been granted here on the reasoning in *Daillioux* (Pet. App. 3a-4a). (See note 4, *supra,* pp. 7-8). Its holding, however, was that the mark "S. Seidenberg & Co's." was "primarily merely a surname." Although acknowledging that that mark was literally something more than merely or only a surname, the court concluded that it was *primarily* only a surname, stating that (Pet. App. 5a):

> It seems to us that "Seidenberg" is clearly a surname which can have no other meaning or significance than that of a surname. Nor do we believe that the addition of the single initial is sufficient to remove it from that category. Further, the addition of the expression "& Co's.," whether it be in the abbreviated and possessive form present here, or in the usual form, cannot be held to distinguish or relate to anything except the surname "Seidenberg."

Applying this reasoning to the present case, "J C Higgins" is equally "*primarily* merely a surname."[6]

CONCLUSION

The decision of the Patent Office and both courts below is correct, and there is no conflict of decisions. It is respectfully submitted that the petition for a writ of certiorari should be denied.

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SEPTEMBER, 1953.

[6] It should be noted that denial of registration under Section 2(e) does not deny to petitioner the right to registration of the mark. Registration is still available under Section 2(f), *supra*, p. 3, if petitioner can establish "proof of substantially exclusive and continuous use" of the mark for a period of five years.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1953.

No. 240

SEARS, ROEBUCK AND CO.,
Petitioner,

vs.

ROBERT C. WATSON, Commissioner of Patents,
Respondent.

PETITIONER'S REPLY MEMORANDUM.

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IN THE

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SEARS, ROEBUCK AND CO.,
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ROBERT C. WATSON, Commissioner of Patents,
Respondent.

PETITIONER'S REPLY MEMORANDUM.

Despite anything said in Respondent's brief, we adhere to our contention that the Patent Office and the appellate tribunals *in this case* (and we are concerned here only with the case at bar and the J. C. HIGGINS type of trade-mark here involved) is adhering to the philosophy of the now obsolete 1905 Act.

At the risk of tedium, we repeat that the Commissioner plainly stated in *Ex Parte Dallioux*, 83 USPQ 262, 263, that the practice of the Patent Office Examining Staff in refusing registration of name trade-marks as exemplified by ANDRE DALLIOUX (and this same practice had likewise been applied to other name marks such as J C HIGGINS), had been

> *"to continue the rule of the Act of 1905,* even though the prohibition against registration of a mark consisting of the name of an individual (which included surnames but was not restricted thereto), no longer remains in the law." (Emphasis added.)

Despite the bouquets of alleged "liberality" laid on the doorstep of the Patent Office by Respondent, the fact remains that the Patent Office has accepted the *Dallioux* ruling only in its *narrowest* sense as applicable only to names of the "John Smith" character on the obviously mistaken theory that the Act permits registration only of *full* names, as pointed out in our Petition, and this inconsistency was recognized by the Court of Customs and Patent Appeals in *In re I. Lewis Cigar Mfg. Co.*, 98 USPQ 265, 266.

Respondent, like the tribunals herebelow, persists in attempting to apply the 1905 Act to this case, devoting most of pages 4 and 5 of the brief to a discussion of the decisions under that law in an attempt to reach a conclusion on the question of whether or not the mark J C HIGGINS is "dominated" by a surname. One of the extreme cases cited under the 1905 Act, *In re Sears, Roebuck and Co.*, 132 F. 2d 341, 49 USPQ 507 (CCPA), went so far as to hold unregistrable a trade-mark consisting of a fanciful drawing of a man's head subscribed, "Thriftily yours, Bob Burnham", on the alleged ground that the name of the individual was the dominant feature of the mark. Respondent urges that the same philosophy should be applied here—although Respondent agrees that a major purpose of the Lanham Act was to *liberalize* such extreme, rigid and hypertechnical rulings.

Misinterpretation of "primarily" is the crux of the error.

Respondent adopts the erroneous interpretation of the word "primarily" of the tribunals herebelow, where Re-

spondent's brief (pp. 6-7) refers to this word "as a modifier of 'merely'", just as the Court of Appeals in its opinion stated that it considered the trade-mark J C HIGGINS "principally merely a surname and, therefore, primarily merely so." (R. 84.)

Contrary to that assumption, it is clear that the Congress intended the word "primarily" to modify the word "surname". The consequent *difference in meaning* of the Section *is radical.*

Turning to the Congressional Hearing Reports (R. 65-66), after discussing the Patent Office practice under the 1905 Act as to name trade-marks, according to which any word mark was refused if it could be found in any telephone book, whether it was a common or a rare name, Mr. Edward S. Rogers, major draftsman of the Lanham Act, stated (R. 66):

"Mr. Rogers: Well, Johnson is *primarily a surname*, Cotton is not".

* * *

Mr. Rogers: Suppose we make it read: "Is *primarily* a surname"?

From this colloquy, which culminated in adoption of the term "primarily merely a surname" in Section 2(e)(3), it is apparent that the Congress intended this language to be identical in significance with *primarily a surname and merely a surname.*

This interpretation of the Section has been recognized by leading authorities in trade-mark law. Thus, in an article by Bartholomew Diggins, Special Assistant to the Attorney General of the United States, "The Lanham Trade-Mark Act", 37 T.M. Rep. 305, 315, this authority states:

> "The word 'primarily' in Section 2(e)(3) is also of importance and did not appear in the 1905 Act. The word 'primarily' indicated that to be registrable the mark must be recognized by the public as a surname—that is, as identifying an individual rather than as a mark identifying good will. In other words, it would appear that even a surname is registrable if to the public it identifies a source of merchandise rather than an individual."

Obviously, the author is talking about registration without recourse to Section 2(f) because he proceeds in the next paragraph to discuss Section 2(f).

Walter J. Derenberg, formerly Solicitor for the Commissioner of Patents for Trade-Mark Administration, in the recently published "Sixth Year of Lanham Act Administration", 98 USPQ, Part II, pp. 1, 4-5, has included a revealing section on *What Constitutes "Primarily Merely A Surname"?* and on page 5 thereof states:

> "The word 'primarily' also causes difficulty where the name involved, although a common surname, has other meanings at the same time." (Appendix A, p. 2a, hereof.)

The Patent Office, in its recent decision in *Ex Parte Keuffel & Esser Co.*, 96 USPQ 216, has now recognized the true significance of the word "primarily". In reversing the Examiner's refusal to register the mark "Samson", the Examiner in Chief states:

> "While the term 'Samson' is used as a surname, it is also common as a given name. The word primarily refers to the well-known Biblical character • • •".

Significance. This misinterpretation in the instant case, construing the word "primarily" as modifying "merely" instead of as modifying "surname", as intended by Congress, leads directly to the erroneous conclusion of the tribunals and adopted in Respondent's brief. By reading "primarily" as modifying "merely", the term "primarily

merely a surname" becomes synonymous with *essentially a surname;* or, as paraphrased in Respondent's brief, p. 9, the expression is construed to mean that a mark is unregistrable "if a surname was the dominant feature of the mark". *The Act says nothing whatever about "dominant feature".*

But construing "primarily" as intended by the Congress and, as now belatedly recognized by the Patent Office in the "Samson" case and by other authorities, as modifying "surname", the expression "primarily merely a surname" should be interpreted as: *the principal significance of which is* **NOTHING BUT** *a surname.*

This interpretation accepts the meaning of "primarily" intended by the framers of the section and recognized by the authorities noted above, and likewise follows the standard dictionary definition of "merely".

Under this interpretation J C HIGGINS unquestionably is properly registrable.

CONCLUSION.

The present situation with regard to the application of Section 2(e)(3) cries loudly for clarification by this Court.

Walter J. Derenberg, in his just published "Sixth Year of Lanham Act Administration", 98 USPQ, Part II, pp. 1, 4-5, in a long section on Section 2(e)(3), Appendix A hereof, refers repeatedly to "the anomalous results" which he considers "incongruous and unjustifiable" in the various rulings of the Patent Office, the Court of Customs and Patent Appeals and the Court of Appeals for the District of Columbia Circuit in these various name cases, viz: *Andre Dallioux, J C Higgins, Kimberly-Clark* and *S. Seidenberg & Co.'s.*

That the Trade-Mark Law of 1946 was lacking in clarity was recognized at its inception.[1]

Respondent, by indicating at two places in the brief (p. 4 and Footnote 6, p. 11) that registration is available to Petitioner under Section 2(f), may be insinuating that this petition is of a frivolous character. Such suggestion is *strenuously denied.* On the contrary, it is generally felt in the profession that registration with or without recourse to Section 2(f) may represent a serious difference to the registrant from the standpoint of *burden of proof,* in the event of litigation. In this connection see *Conde Nast Publications, Inc.* v. *Vogue School,* 94 USPQ 101, 105 (SD NY, 1952). The matter is thus of great importance in the protection of trade-mark rights of Petitioner as well as industry in general.

It is accordingly urged that the Petition for Certiorari be granted.[2]

Respectfully Submitted,

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September 25, 1953.

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[1] Derenberg stated in 1947 that the Act "may have suffered somewhat in clarity and purpose * * *". At the Threshold of the Lanham Act, 37 T.M. Rep. 297.

[2] His Honor, Judge Keech, in Shell Development Co. v. The Pure Oil Co. et al, 96 USPQ 309, 312 (DC, Dist. of Col., 1953), in an action under RS 4915, quoted from this Court's opinion in Morgan v. Daniels, 153 US 120, 125, to the effect that the plaintiff in such a suit has the heavy burden of overcoming the Patent Office decisions "by testimony which in character and amount carries thorough conviction". Despite recognition of such "heavy burden", the same Court in the instant case, also under RS 4915, barred the plaintiff from putting in practically any proofs whatsoever.

APPENDIX A.

The Sixth Year of Administration of the Lanham Trade-Mark Act of 1946.

(A Progress Report to be submitted to the Section of Patent, Trade-Mark and Copyright Law of the American Bar Association, at its Annual Convention at Boston, Mass., August 23, 1953), by Walter J. Derenberg.

3. What Constitutes "Primarily Merely A Surname"?

Since the decision of the Court of Appeals for the District of Columbia in the "Kimberly Clark" case last year and the Commissioner's ruling in the "Andre Dallioux" case, it seemed established that a person's *entire* individual name, such as Andre Dallioux, was not "primarily merely a surname" and therefore registrable without reference to Section 2 (f) of the Act, while a combination of two surnames, such as "Kimberly Clark", was considered registrable only upon proof of distinctiveness under Section 2 (f). In the meantime, the borderline case of registrability of a family name with initials, which, according to the Commissioner's decision in the Dallioux case, might not come within the scope of that ruling, was squarely presented to the Court of Appeals of the District of Columbia in connection with the registrability of the trade-mark "J. C. Higgins". The Commissioner had held, following the dictum of the Dallioux case, that "adding the initials to the surname does not change the mark as a whole from being primarily merely a surname." Rather than convert the application to one under Section 2(f), the applicant chose to bring suit against the Commissioner under R.S. 4915. The Court of Appeals ruled that "J. C. Higgins" while not merely a surname, was "primarily merely" a surname. The District Court's decision, which had been to the same effect, was affirmed without prejudice to applicant's filing of a new application under Section 2(f) of the

Act of 1946. The Court of Appeals thus agreed with the viewpoint which had prevailed in the Patent Office ever since the Andre Dallioux decision, without commenting upon the rather *anomalous results* which follow from this interpretation. While it may be true that a strict interpretation of the statutory language must result in the conclusions reached in the Kimberly Clark, Dallioux and Higgins cases, it still remains *incongruous and unjustifiable* to permit registration without reliance on Section 2(f) of such common names as "Paul Jones" or "Robert Smith" while, at the same time, permitting registration under Section 2(f) only of such much more arbitrary and distinctive combinations of surnames as, for instance, "Kimberly Clark" and innumerable others. It has already become apparent that the statutory language "primarily merely a surname" has been rather unfortunate since it seems to be too restricted as applied to many famous surname combinations, and far too liberal in seemingly permitting everyone to register his own name as a trademark as long as he spells out his full Christian name rather than merely uses his initials as in the J. C. Higgins case.

The apparent *anomaly* here pointed out has just been noted by the Court of Customs and Patent Appeals in its decision of July 31, 1953, affirming the Patent Office's rejection of the application to register the notation *"S. Seidenberg & Co's."* as a trade-mark without reliance on Section 2(f). The Court, after hearing reargument on the legislative intent of Section 2(e), came to the conclusion that the notation was "primarily merely a surname" but not without indicating that, in its judgment, the notation "Andre Dallioux" should have likewise been rejected on the ground that "Dallioux", the surname, was the dominant part of that mark.

The word "primarily" also causes difficulty where the name involved, although a common surname, has other meanings at the same time. (Emphasis added.) • • •

APPENDIX B.

Additional Authorities Supporting Certiorari.

(1) *Fullerton-Krueger Lumber Co.* v. *Northern Pacific R. R.*, 266 U.S. 435, 45 Sup. Ct. 143, holds that certiorari is appropriate to review a judgment in a suit wherein a right under an Act of Congress was claimed and denied.

(p) *Federal Trade Commission* v. *American Tobacco Co.*, 274 U.S. 543, 71 L. ed. 1193, holds that where the future administration of a law may be seriously hindered by the judgment sought to be reviewed, such is sufficient reason for granting a writ of certiorari.

(3) *Whitney Bowles* v. *United States*, 319 U.S. 33, holds that certiorari may be granted where a Federal Court of Appeals has decided an important question of Federal law which has not been but should be settled by the Supreme Court.